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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,143	12/02/2003	David K. Swanson	03-0312 (US01)	5314

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VISTA IP LAW GROUP LLP  
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EXAMINER
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ROANE, AARON F

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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03/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,143	<b>Applicant(s)</b> SWANSON, DAVID K.	
	<b>Examiner</b> AARON ROANE	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 27-40, 42-44 and 46-54 is/are pending in the application.
- 4a) Of the above claim(s) 7, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 27-36 and 39-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-10, 27-34, 36 and 39-47 and 49-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Maguire et al. (USPN 5,755,760).

Regarding claims 1, 27, 30 and 47, Maguire et al. disclose a device comprising: a single, relatively short tubular shaft (460 and alternate/equivalent counterparts in other embodiments) defining a distal region and a proximal region; a coagulation element or means for coagulating tissue (12 and/or 16 and alternate/equivalent counterparts in other embodiments) defining a coagulation element configuration on the distal region of the relatively short tubular shaft; and a stimulation element or means for stimulating tissue (20 and alternate/equivalent counterparts in other embodiments) defining a stimulation element configuration on the distal region of the same relatively short tubular shaft, the stimulation element configuration being different than the coagulation element configuration, see col. 3-16, col. 3, line 43 through col. 7, line 45 in particular and figures

1-16. Maguire et al. further disclose a source of stimulation energy and a source of coagulation energy, col. 14, line 24 through col. 15, line 18 and figure 16.

Regarding claims 2-4 and 31-33, Maguire et al. disclose the claimed invention, see figures 1-9B.

Regarding claims 5, 6, 9, 10, 34, 49, 50, 53 and 54, Maguire et al. disclose the claimed invention, see col. 3, line 43 through col. 4, line 14 and figures 1-9B.

Regarding claim 36, et al. further disclose the source of stimulation energy is configured for monitoring electrical impulses sensed by the stimulation element, see col. 3-16, col. 3, line 43 through col. 7, line 45 in particular and figures 1-16.

Regarding claim 28 and 29, Maguire et al. further disclose a coagulation energy line (102 and 104 and alternate/equivalent counterparts in other embodiments) connected to the coagulation element and to a coagulation energy connector configured to be connected to the source of coagulation energy; and a stimulation energy line (118 and alternate/equivalent counterparts in other embodiments) connected to the stimulation element and to a stimulation energy connector configured to be connected to the source of stimulation energy. It should be further noted that the stimulation element and the coagulation element have different configurations, see col. 3-16, col. 3, line 43 through col. 7, line 45 in particular and figures 1-16.

Regarding claims 39 and 43, Maguire et al. further disclose the coagulation element and the stimulation element are carried on the same relatively short tubular shaft such that the coagulation element and the stimulation element are longitudinally fixed relative to one another, see col. 3, line 43 through col. 7, line 45 in particular and figures 1-9B.

Regarding claims 40 and 44, Maguire et al. further disclose the distal portion of the relatively short tubular shaft includes a unitary outer member (14 16 and alternate/equivalent counterparts in other embodiments) and the coagulation element and the stimulation element are both carried on the unitary outer member, see col. 3-16, col. 3, line 43 through col. 7, line 45 in particular and figures 1-16.

Regarding claims 42 and 46, Maguire et al. further disclose the coagulation element and the stimulation element define respective diameters and the diameter of the coagulation element is substantially equal to the diameter of the stimulation element, see col. 3-16, col. 3, line 43 through col. 7, line 45 in particular and figures 1-16.

Regarding claims 51 and 52, Maguire et al. further disclose the relatively short shaft is linear, see col. 3-16, col. 3, line 43 through col. 7, line 45 in particular and figures 1-16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 35, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire et al. (USPN 5,755,760) as applied to claims 1, 27 and 47 above, and further in view of Haissaguerre et al. (USPN 6,063,080).

Regarding claims 8, 35 and 48, Maguire et al. disclose the claimed invention except for at least a portion of the distal region of the relatively short tubular shaft is malleable.

Haissaguerre et al. disclose a catheter having steering capability and electrodes (28) and teach providing the distal portion of the catheter (40) with shape memory material in the form of nickel-titanium in order to set the shape of the distal portion, see col. 3, lines 35-51 and figures 1-8, Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Maguire et al., as taught by Haissaguerre et al., to provide the distal portion of the catheter with shape memory material in the form of nickel-titanium in order to set the shape of the distal portion.

***Response to Arguments***

Applicant's arguments with respect to claims 1-6, 8-10, 27-36, 39, 40, 42-44 and 46-54 have been considered but are moot in view of the new ground(s) of rejection. The claims have been rejected by the Maguire et al. individually or with the combination of Maguire et al. and the Haissaguerre et al. patents.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON ROANE whose telephone number is (571)272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy D. Gibson/  
Primary Examiner, Art Unit 3739

/Aaron Roane/  
Examiner, Art Unit 3739